

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** PETER F. BEMIS and AMELIA H. NEWAR and  
STEVEN J. KOLSTE and WILLIAM J. GENETT

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Appeal No. 96-2270  
Application 08/073,108<sup>1</sup>

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ON BRIEF

Before MEISTER, ABRAMS and FRANKFORT, **Administrative Patent Judges.**

MEISTER, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 14-17,

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<sup>1</sup>Application for patent filed June 8, 1993.

22-25 and 31-40.<sup>2</sup> Claims 18-21 and 26, the only other claims present in the application,

have been indicated as being allowable subject to the requirement that they be rewritten to include all the subject matter of the claims from which they depend. We reverse.

The appellants' invention pertains to a medical suction system and to a method for handling medical waste. Independent claims 14 and 35 are further illustrative of the appealed subject matter and read as follows:

14. A medical suction system comprising:

a suction canister for holding fluid drained from a patient, said suction canister including a suction port for communication with a vacuum source and a patient port for communication with a patient, and

a cleaning station for removably supporting said suction canister and for automatically draining and cleaning said suction canister after said suction port is disconnected from the vacuum source and said patient port is disconnected from the patient.

35. A method for handling medical waste, said method comprising the steps:

(a) collecting fluid from a patient in a stand-alone suction canister having an interior, a suction port for communication with a vacuum source, and a patient port

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<sup>2</sup> Claims 25 and 31 have been amended subsequent to final rejection by an amendment filed on March 20, 1995 (Paper No. 13). Although the examiner has stated on page 1 of the answer that this amendment has been entered, we observe that no clerical entry thereof has in fact been made.

for communication with a patient;

(b) providing a cleaning station for removably supporting said suction canister and for automatically draining and cleaning said suction canister;

(c) placing said suction canister in communication with said cleaning station; and

(d) activating said cleaning station so that said cleaning station drains the fluid from the interior of said suction canister and cleans the interior of said suction canister.

The references relied on by the examiner are:

Baxter	2,004,027	Jun. 04, 1935
Keller	2,073,746	Mar. 16, 1937
Mertens et al. (Mertens)	5,033,492	Jul. 23, 1991

The claims on appeal stand rejected under 35 U.S.C. § 103 in the following manner:<sup>3</sup>

(1) Claims 14, 22, 31, 32, 35 and 37-40 as being unpatentable over Keller;

(2) Claims 15-17 as being unpatentable over Keller in view of Mertens;

(3) Claims 23-25 and 34 as being unpatentable over Mertens in view of Baxter; and

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<sup>3</sup> Page 3 of the answer makes reference to both Paper Nos. 7 and 11 for an explanation of these rejections. Such a procedure by the examiner is totally improper and inappropriate. Manual of Pat. Examining Procedure (MPEP) § 1208 (6th ed., Rev. 3 Jul. 1997) expressly provides that incorporation by reference may be made only to a **single** other action.

(4) Claim 36 as being unpatentable over Keller in view of Baxter.

**Rejections (1), (2) and (4)**

It is the examiner's position that:

Keller discloses the method and apparatus substantially as claimed, however, Keller is silent as to the intended use of cleaning medical containers with suction ports therein.

As concerns this deficiency in intended use, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art that if it was desired to clean and reuse suction canisters that such a device as that taught by Keller would have been utilized, as the device of Keller is non-discriminatory as to what type of canister or bottle it cleans. [Final rejection, page 3.]

From the above, it is readily apparent that the examiner is simply dismissing the specific limitations as to the type of container being cleaned as being a matter of "intended use" since, in the examiner's view, the device of Keller is "non-discriminatory" as to the type of canister that it cleans. We will not support the examiner's position. All limitations in a claim must be considered and it is error to ignore specific limitations that distinguish over the references. **See In re Boe**, 505 F.2d 1297, 1299, 184 USPQ 38, 40 (CCPA 1974) and **In re Wilson**, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Here, independent claims 14 and 40 are directed to a **medical system** which includes a suction canister having a suction port and a patient port while independent claim 35 is directed to a **method** for handling medical waste which includes the step of collecting fluid from a patient in a stand-alone canister having a suction port and a patient port and, accordingly, the specifically claimed canister forms a part of the claimed medical system and method. The examiner, however, has not provided a factual basis for establishing that it would have been obvious to employ the cleaning device of Keller to clean this specifically claimed suction canister.<sup>4</sup> "A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The examiner] may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in . . . [the] . . . factual basis." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968)). In short, it does not follow that just

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<sup>4</sup> While there is nothing in the prior art relied on by the examiner for establishing that a suction canister having a suction port and a patient port is old or well known in the art, we observe that the appellants on page 1 of the specification have indicated that such canisters have been previously been employed to drain bodily fluid from a patient.

because the device Keller is employed to clean bottles (which are to be used for containing food products - see page 1, column 1, second paragraph) that it would have been obvious to utilize Keller's device to clean a suction canister having both a suction port and a patient port as the examiner apparently believes. Moreover, it is not even readily apparent that the device of Keller has the ***inherent capability*** of cleaning such a canister. In this regard, it should be noted that while it is well settled that a claimed functional limitation directed to a new intended use of an old apparatus does not in and of itself make a claim drawn to an apparatus patentable over the old apparatus, it is nevertheless necessary that the old apparatus (e.g., the apparatus of Keller) be inherently capable of performing the recited intended use in order to satisfy the functional limitation in question. ***See, e.g., In re Schreiber***, \_\_ F.3d \_\_, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

With respect to method claims 35 and 37-39, we additionally observe that 35 U.S.C. § 100(b) specifically recognizes a new use of a known machine as proper subject matter for a patent. See also ***Ex parte Markowitz***, 143 USPQ 303, 305 (Bd. App. 1964).

As to claims 15-17 and claim 36 we have carefully reviewed the teachings of Mertens and Baxter but find nothing therein

which would overcome the deficiencies already noted with respect to Keller.

In view of the foregoing, we will not sustain the rejections under 35 U.S.C. § 103 of (1) claims 14, 22, 31, 32, 35 and 37-40 based on the teachings of Keller alone, (2) claims 15-17 based on the combined teachings of Keller and Mertens and (3) claim 36 based on the combined teachings of Keller and Baxter.

### **Rejection (3)**

According to the examiner:

Mertens does not disclose the container (2) to provide indica that the container has been cleaned comprising a punched tab in the container.

Baxter shows it is old and well known within the art to the ordinarily skilled artisan (lines 35-45 of the second column of page 3) to provide indicia of the container status with a punched tab portion.

It would have been obvious to said artisan to modify the container of Martens per the above cited teaching of Baxter for the same reason. [See the Office action dated March 28, 1994 (Paper No. 7), pages 4 and 5.]

Independent claim 23 expressly requires a medical suction system comprising a suction canister having a suction port and a patient port. There is, however, absolutely nothing in the combined teachings of Mertens and Baxter which would suggest such an arrangement. Mertens has a **single** opening 2a in the top of a

drum 2 through which concentric pipes are inserted for the purpose of providing a rinsing fluid 7 under pressure via outer pipe 20 and thereafter removing the fluid via inner pipe 10 which is connected to a pump 6. We find nothing, nor does the examiner even allege there is anything, in Baxter which would suggest modifying the drum or canister 2 of Mertens to include a suction port and patient port as claimed.

Moreover, we cannot agree with the examiner that there is anything in the combined teachings of Mertens and Baxter to suggest modifying the device of Mertens to include the limitation expressly set forth in independent claim 23 of:

an indicator for altering said suction canister in response to cleaning thereof so as to provide a visible indication that said suction canister has been cleaned.

While Baxter broadly teaches an indicator, Baxter's canister or container is for holding sterile fluids such as intravenous solutions and is not altered in response to cleaning as claimed. Baxter merely provides a flexible sealing disk 13 which loosely overlies air inlet 11 and fluid discharge opening 12 and, when a vacuum is properly maintained in the container, the sealing disk is visibly cupped or depressed around the air inlet and fluid discharge openings. If, however, the seal in Baxter should somehow be broken, then the sealing disk is no longer cupped or



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indented.

Since we find nothing in the combined teachings of Mertens and Baxter, which would fairly suggest modifying the canister or drum of Mertens by (1) providing suction and patient ports and (2) altering the canister to provide a visible indication that the canister has been cleaned, we will not sustain the rejection of claims 23-25 and 34 based on these two references.

The examiner's rejections under 35 U.S.C. § 103 are all reversed.

**REVERSED**

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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David R. Price  
Michael, Best & Friedrich  
100 East Wisconsin Avenue  
Milwaukee, WI 53202-4108